

REMARKS

Favorable reconsideration and allowance of the present patent application are respectfully requested in view of the following remarks. Claim 3-4 and 6-10 were pending prior to the Office Action. Claims 3-4 and 6 have been canceled and claims 11-12 have been added by this Reply. Therefore, claims 7-12 are pending. Claim 7 is independent.

Claim Objection

In the Office Action, claim 8 is asserted to be dependent on a canceled claim. *See Office Action, page 9.* However, Applicant notes that it is claim 9, not claim 8, that depends from claim 1. Applicant has amended claim 9 as shown. Applicant respectfully requests that the objection to the claim be withdrawn.

35 U.S.C. § 103 Rejection Based on Fukuda

Claims 3-4 and 6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Fukuda et al (EP 0 838 767 A2) ("Fukada"). These claims have been canceled rendering the rejection moot. Applicant respectfully request that the rejection of claims 3-4 and 6, based on Fukada, be withdrawn.

35 U.S.C. § 103 Rejection Based Hatanaka

Claims 7-10 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Hatanaka (USPN 6,438,320) ("Hatanka"). Applicant respectfully traverses.

For a Section 103 rejection to be valid, a *prima facie* case of obviousness must be established. See *M.P.E.P. 2142*. One requirement to establish *prima facie* case of obviousness is that the prior art reference must teach or suggest all claim limitations. See *M.P.E.P. 2142*; *M.P.E.P. 706.02(j)*. Thus, if the cited reference fails to teach or suggest one or more claimed elements, then the rejection must fail.

Another requirement to establish *prima facie* case of obviousness is that there must be a suggestion or motivation within the cited reference to modify the reference as proposed in the Office Action. See *M.P.E.P. 2143.01*. The cited reference must be considered in its entirety including disclosures that teach away from the claimed invention. See *M.P.E.P. 2142.02*. If the proposed modification renders the cited reference unsatisfactory for its intended purpose, then by definition, there is no suggestion or motivation to make the proposed modification. See *M.P.E.P. 2143.01*. Thus, if the proposed modification renders the cited reference unsatisfactory for its intended purpose, the rejection must also fail.

As will be shown below, this rejection fails on both accounts. First, Hatanaka fails to teach or suggest all claimed features of independent claims 7 and 10. In the Office Action, it is stated, "Hatanaka does not explicitly disclose a first loadable and removable recording medium; a second loadable and removable recording medium, and the image-file from the first the first recording medium is read out for changing the file name and recording on the second recording medium." *Emphasis added; See page 7 of the Office Action beginning on line 10.* Thus, it is admitted in the Office Action that Hatanaka fails to teach all claimed features.

The Office Action, however, goes onto assert that the file management system shown in Figure 2 of Hatanaka somehow corrects this deficiency since the operation of the camera "could" be implemented in the computer connected to the camera and the computer "could" include a high capacity floppy disk. *See Office Action beginning on line 21 and continuing on to page 8.*

However, Applicant notes that Hatanaka itself does not indicate that the operation of the camera "could" be implemented in the computer nor does Hatanaka indicate that the computer "could" include the high capacity floppy disk. Thus, in addition to failing to teach, Hatanaka also fails to suggest the claimed features.

Second, the proposed modification renders Hatanaka unsatisfactory for its intended purpose. Applicant notes that Hatanaka identifies as a problem,

“when it is intended to transfer data from the storage device of the electronic camera to a computer, there is a possibility such that files of the same name also exist in an auxiliary storage device of the computer.” *See column 1, lines 29-32.* This is a problem because when the files are transferred to the computer, the files with the same names may be overwritten and corrective actions are necessary on the computer side. *See column 1, lines 32-36.*

Hatanaka solves this problem as follows. Hatanaka is directed toward generating unique names for a single device, such as a digital camera, across multiple recording mediums. For example, a particular camera may be used to record images on multiple flash cards. All of the file names generated by that camera will be unique across the multiple flash cards.

If unique names are generated in the camera, then it is possible to prevent “a plurality of files of the same names exist.” *See column 1, lines 62-67.* By preventing the possibility of same names existing in the first place, then overwriting of files on the storage of the computer is prevented and corrective actions are not necessary on the computer side.

In the Office Action, it is stated, “the Hatanaka process ... could be implemented in the operating system 15 of the computer.” *See Office Action, page 7, lines 21-22.* In other words, it is proposed that Hatanaka be modified such that 1) a single camera may generate same files names, and 2) take

corrective actions at the computer when same file names are seen between the camera medium and the hard disk of the computer.

This is exactly the situation Hatanaka has identified to be a problem and is directed toward solving. Clearly, the proposed modification renders Hatanaka unsatisfactory for its intended purpose.

Still further, Applicant notes that even if the operations of the camera were moved to the computer, it still would not result in the features as claimed. Clearly, the camera does not operate to compare between file names on one medium to the file names on another medium. The camera determines a current file number from a recordable medium and compares this to the maximum file number held in a threshold memory 36. *See Figures 3 and 4A-4D.* If the current file number exceeds the threshold, an exception handling process is invoked. *See column 8, lines 27-53.*

Because the camera does not operate to compare file names between multiple recordable mediums, moving the camera operation to the computer will not operate to compare file names either.

Therefore, for at least these reasons, claim 7 and 10 are distinguishable over Hatanaka. Claims 8-9 depend from claim 7. Therefore, for at least the reasons stated with respect to claim 7, claims 8-9 are also distinguishable over Hatanaka.

Applicant respectfully requests that the rejection of claims 7-10, based Hatanaka, be withdrawn.

NEW CLAIMS

Claims 11-12, which depend from claim 10 directly or indirectly, have been added through this reply. Therefore, for at least the reasons stated above, these claims are believed to be distinguishable over the cited references.

Applicant respectfully requests that the claims 11-12 be allowed.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Hyung Sohn (Reg. No. 44,346), to conduct an interview in an effort to expedite prosecution in connection with the present application.

Attached hereto is a marked-up version of the changes made to the application by this Reply.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit

Appln. No. 09/490,061

Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: Version with Markings to show changes made

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS

Claims 3-4 and 6 have been canceled without prejudice or disclaimer of the subject matter contained therein.

9. (ONCE AMENDED) The apparatus according to claim [1] 8, wherein said grouping device causes a file name corresponding to each group to be recorded on the second loadable and removable recording medium.

Claims 11 and 12 have been added.